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Attorney's Docket: 2003DE101
Serial No.: 10/542,528
Art Unit 1626

Response to Office Action, Dated 08/21/2006

Remarks

The Office Action mailed August 21, 2006 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

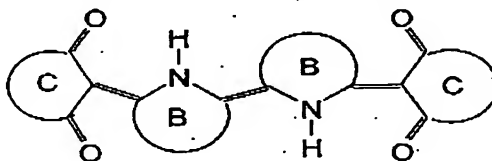
Applicant would like to thank the Examiner for an opportunity to discuss the restriction requirement in a telephonic interview with Applicant's representative Mr. Richard Silverman on November 8, 2006. Applicant pointed out that there was an apparent misunderstanding in the telephone election of July 31, 2006. In the telephone election, Applicant intended that the elected species be based on Applicant's Example 2, not the Examiner's Group II, which was not the subject of the instant invention, but directed to a Comparative Example. Applicant's Example 2 comprised compounds wherein C was an N-alkylated barbituric acid. The Examiner agreed to perform a new search based on Applicant's Example 2.

Applicant has amended the claims to more clearly recite what Applicant believes to be the invention. The dependency of claim 12 was amended to depend from claim 3 to provide a proper antecedent basis for the recitation of the variables *n* and *m*. It is believed that no new matter was introduced by this amendment.

Claim 12 was rejected under 35 U.S.C. §112, second paragraph, for not pointing out and distinctly claiming the subject matter which Applicant regards as the invention. The rejection of claim 12, as amended, under 35 U.S.C. §112, second paragraph, for not pointing out and distinctly claiming the subject matter which Applicant regards as the invention should be withdrawn in light of the above amendment which now recites that claim 12 depends from claim 3, which provides the antecedent basis for the terms *n* and *m* in claim 12.

Restriction:

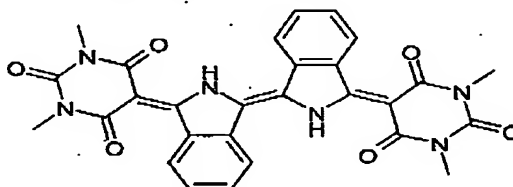
In a telephone conversation with Anthony Bisulca on July 31, 2006, Applicant believes that a provisional election was made to compounds of Example 2, wherein with reference to formula (1) reproduced hereinbelow:



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wherein the substituents C in the compounds of formula (1) are C_{2v} -symmetric molecules; that is, they possess the symmetry elements of the identity, one C_2 axis and two mirror planes which are orthogonal to one another and whose intersect provides the C_2 axis (See Applicant's Specification at page 2, lines 24-27). An example of such a C-substituent is given in Example 2 on page 9 of Applicant's Specification as



where C is an N-alkylated barbituric acid. In order to advance the case, and in accordance with 37 CFR 1.499, Applicant respectfully requests that the selection of a single invention to which the claims must be restricted be considered is the above compound which is based on C as an N-alkylated barbituric acid. This option is not one of the 12 groups suggested by the Examiner. The Examiner's Groups I-VIII do not contain an N-alkylated barbituric acid moiety. Group I refers to a thio barbituric acid. Groups II and III, VI, VII, X and XI refer to Applicant's comparative examples, which are not the subject of Applicant's elected invention. Applicant requests that the Examiner reconsider which claims or portions thereof must be withdrawn in light of Applicant's proposed election as stated herein.

Claims 1-7 and 12 were objected to for containing elected and non-elected subject matter. Applicant respectfully requests that the objection to claims 1-7 and 12 be reconsidered in view of Applicant's proposed election in response to the above restriction requirement.

Claims 1-6 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 2,254,354 to Davies. The rejection of claim 1 as amended under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 2,254,354 to Davies should be withdrawn for the reason that the Davies is silent on any molecular structure having C_{2v} symmetry, or the concept of C_{2v} symmetry. Davies discloses β -isoindigo compounds which are substituted by a cyclic radical containing at least one $=CH_2-CO-$ group, but the compounds disclosed in the Davies patent are dull in color and have other limitations. Applicant's invention is directed to provide improved β -isoindigo pigments having higher cleanness and brightness as well as other improved properties. Furthermore, all of the examples of Davies are unsymmetrical compounds. Still further, there is no mention of

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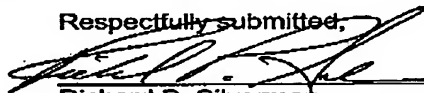
barbituric acid moieties in Davies. No limitations of a claim which serve to identify the invention should be ignored. All words in a claim must be considered in judging the patentability of that claim against the prior art. The undisputed fact of the matter is that Davies teaches nothing regarding any improved β -isoindigo compound having C_{2v} symmetry and a barbituric acid moiety. Thus, no one skilled in the art, armed with the Davies Patent US 2,254,354 would be motivated to arrive at any molecules having a molecular structure having C_{2v} symmetry, and no one skilled in the art at the time of Applicant's invention, armed only with the disclosure of Davies would arrive at a molecular structure having C_{2v} symmetry based on a barbituric acid moiety. Therefore, the rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 2,254,354 to Davies should be withdrawn for the reason that the determination of obviousness must be based on facts and not on unsupported generalities. The rejection of claims 2-6 and 12 under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 2,254,354 to Davies should be withdrawn for the reasons given in support of claim 1 from which claims 2-6 and 12 depend.

Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 2,254,354 to Davies. The rejection of claim 7 under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 2,254,354 to Davies should be withdrawn for the reason that the Davies Patent does not disclose any of the starting materials, or the finished product recited in claim 7, and that any rejection of claim 7 should be withdrawn for the reasons given in support of claim 1 from which claim 7 depends.

It is respectfully submitted that, in view of the above remarks, the restriction requirement has been met and the objections to the claims and the claim rejections under 35 U.S.C. §112, and §103 should be withdrawn and that this application is in a condition for an allowance of all pending claims. Accordingly, favorable reconsideration and an allowance of all pending claims are courteously solicited.

An early and favorable action is courteously solicited.

Respectfully submitted,


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